
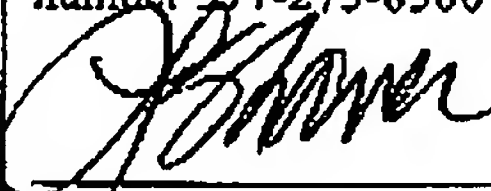


JAN 18 2011

PRE-APPEAL BRIEF REQUEST FOR REVIEW (filed with the Notice of Appeal)		Docket Number 042933/314689
Application Number 10/597,862	Filed April 28, 2008	
First Named Inventor Thomas J. Kennedy		
Art Unit 2617	Examiner Barry W. Taylor	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p style="text-align: right;">Respectfully submitted,  Nathaniel T. Quirk Registration No. 60,676</p> <p>Date <u>January 18, 2011</u></p> <p>Customer No. 00826 ALSTON & BIRD LLP Bank of America Plaza 101 South Tryon Street, Suite 4000 Charlotte, NC 28280-4000 Tel Charlotte Office (704) 444-1000 Fax Charlotte Office (704) 444-1111</p> <div style="border: 1px solid black; padding: 5px;"><p>I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at facsimile number 571-273-8300 on the date shown below.</p><div style="display: flex; justify-content: space-between;"><div> Linda Shaver</div><div><u>1/18/11</u> Date</div></div></div>		

Attachment

Reasons for Requesting Pre-Appeal Brief Request for Review

Claims 1-9, 11-26, and 28-31 are pending. Claims 10 and 27 were previously canceled. Claims 1-3, 5-7, 9, 11-15, 17-20, 22-24, 26, and 28-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. App. Pub. No. 2004/0137893 to Muthuswamy et al. ("Muthuswamy") in view of U.S. Pat. No. 6,782,251 to Kagay, Jr. ("Kagay"). Claims 4 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Muthuswamy in view of Kagay, and further in view of U.S. Pat. No. 7,103,657 to Adams ("Adams"). Claims 8, 21, and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Muthuswamy in view of Kagay, and further in view of U.S. Pat. No. 5,734,978 to Hayatake et al. ("Hayatake"). In light of the subsequent remarks, Applicants respectfully submit that the rejections should be reversed and the pending claims are in condition for allowance.

The Rejection of Independent Claims 1 and 24 under §103(a) Should be Reversed

Independent Claim 24 is directed to a method comprising receiving, at a mobile device, a disable signal from a remote location. The method further comprises extracting information from the disable signal. The method additionally comprises disabling at least one functionality of the mobile device based at least in part on the extracted information. The method also comprises, in an instance in which the extracted information indicates a tracking function is to be activated to facilitate locating the mobile device, determining a tracking function to activate based at least in part on the extracted information, the tracking function being selected based at least in part on one or more of a time that has passed since the apparatus was lost or stolen or a location in which the apparatus was lost or stolen; and activating the determined tracking function. Amended Claim 1 is directed to an apparatus and includes recitations substantially similar to Claim 24 insofar as this discussion is concerned.

The Office alleges that independent Claims 1 and 24 are unpatentable over the combination of Muthuswamy and Kagay. However, Applicants respectfully disagree, as the combination of Muthuswamy and Kagay fails to teach or suggest each feature recited in Claims 1 and 24. In particular, the combination of Muthuswamy and Kagay at least fails to teach or suggest "determining a tracking function to activate based at least in part on the extracted information, the tracking function being selected based at least in part on one or more of a time that has passed since the apparatus was lost or stolen or a location in which the apparatus was lost or stolen."

The Office admits that "Muthuswamy does not explicitly show...determine a tracking function to activate based at least in part on the extracted information, the

tracking function being selected based at least in part on one or more of a time that has passed since the apparatus was lost or stolen or a location in which the apparatus was lost or stolen,” and instead relies on Kagay as teaching this feature. See, page 3 of the Office Action. In particular, the Office posits:

Kagay teaches an apparatus and method of operating a lost mobile communication device (title, abstract). Kagay teaches using a security module to control security operations of the mobile device (col. 2 line 15 - col. 3 line 6). For example, when a user realizes the mobile device is lost, the user can remotely activate a suspend mode by sending the mobile device a lost communication device message such as SMS, a page, a telephone call, or any other communication useful for communicating that the mobile device has been lost. Kagay teaches (col. 3 line 35 - col. 4 line 16, col. 5 lines 38-52) the security module may also enable an alert sequence (i.e. tracking function) to assist in locating the mobile device if the owner is in a local area (i.e. or a location in which the apparatus was lost or stolen).

It will be appreciated that the Office has failed to even meet its burden of proof of establishing a *prima facie* rejection of Claims 1 and 24. In this regard, as illustrated by the above excerpt from the office Action, the Office has failed to provide any claim construction of the features alleged to be disclosed by Kagay. More particularly, the Office has failed to provide any construction which maps with particularity the cited portions of the disclosure of Kagay to particular claimed features. Applicants remind the Office that in order to make a fair review of the merits of a *prima facie* case of anticipation or obviousness, “[t]he Examiner must make specific findings as to claim construction.” *Ex parte* Beery, Appeal No. 2008-0543, Application No. 09/954,823 (BPAI Sep. 29, 2008) (emphasis added); *Ex parte* Blankenstein et al., Appeal No. 2007-2872, Application No. 10/116,312 (BPAI Aug. 26, 2008); and see *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997); and MPEP §§ 706, 706.07. As such, the Office has failed to establish a *prima facie* rejection of Claims 1 and 24 and the rejection should be reversed for this failure.

In particular, it will be noted that the Office has not made any showing or allegation that alleges with particularity that Kagay teaches or suggests determining a tracking function to activate based at least in part on the extracted information, let alone selection of the tracking function based at least in part on one or more of a time that has passed since the apparatus was lost or stolen or a location in which the apparatus was lost or stolen. In this regard, it will be appreciated that as set forth in the above copied

excerpt from the rejection, the Office has, at most, alleged that Kagay discloses "the security module may also enable an alert sequence (i.e. tracking function) to assist in locating the mobile device if the owner is in a local area (i.e. or a location in which the apparatus was lost or stolen). Even assuming *in arguendo* that Kagay discloses that which the Office alleges, which Applicants do not admit, this alleged disclosure does not teach or suggest determining a tracking function to activate based at least in part on the extracted information, let alone selection of the tracking function based at least in part on one or more of a time that has passed since the apparatus was lost or stolen or a location in which the apparatus was lost or stolen. Mere activation of an alert sequence does not teach or suggest determining a tracking function to activate, let alone selection of a tracking function (e.g., what kind of tracking function, such a homing beacon, audio alarm, GPS positioning, etc, to use) based at least in part on one or more of a time that has passed since the apparatus was lost or stolen or a location in which the apparatus was lost or stolen, as recited by Claims 1 and 24.

Moreover, the Office has clearly taken the disclosure of Kagay out of context. In this regard, the Office seems to imply that the disclosure of "to assist in locating a lost mobile communication device if the owner is in a local area" discloses selection of a tracking function based at least in part on a location in which the apparatus was lost or stolen. However, clearly, when read in context as understood by a person having ordinary skill in the art, the disclosure merely states that an audible alert sequence may be initiated and this alert sequence may assist in locating a lost mobile communication device *if* the owner is in a local area (i.e., within proximity of the mobile communications device). In other words, if the owner is within hearing range, the audible alert may assist. However, there is no teaching or suggestion that the audible alert sequence is selected based on the owner's location, let alone based at least in part on one or more of a time that has passed since the apparatus was lost or stolen or a location in which the apparatus was lost or stolen, as recited in Claims 1 and 24.

In view of the foregoing remarks, it will be appreciated that Kagay does not cure the admitted deficiencies of Muthuswamy. Accordingly, the combination of Muthuswamy and Kagay fails to teach or suggest each feature recited in Claims 1 and 24. Moreover, none of the other cited references, taken alone or in combination, cures the deficiencies of the combination of Muthuswamy and Kagay. Applicants therefore respectfully submit that Claims 1 and 24 are patentably distinct from the cited references, taken alone or in combination, such that the rejection of Claims 1 and 24 should be reversed. Applicants additionally submit that Claims 1 and 24 are in condition for allowance.

The Rejection of Independent Claims 15 and 28 under §103(a) Should be Reversed

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Independent Claim 15 is directed to a method comprising receiving a request to disable at least one functionality of a mobile device. The method further comprises determining a tracking function to activate on the mobile device, the tracking function being selected based at least in part on one or more of a time that has passed since the mobile device was lost or stolen or a location in which the mobile device was lost or stolen. The method additionally comprises causing a disable signal to be broadcast to the mobile device, the disable signal comprising information configured to cause the mobile device to disable at least one functionality and activate the determined tracking function responsive to the disable signal.

The Office Action alleges that Claims 15 and 28 are unpatentable over the combination of Muthuswamy and Kagay. However, Applicants respectfully submit that the rejection should be reversed for at least those reasons set forth in the following remarks.

The Office Has Not Established a *prima facie* Rejection of Claim 15

The Office has failed to even establish a *prima facie* rejection of Claim 15. In this regard, the Office merely posits with respect to Claim 15, "[m]ethod claim 15 is rejected for the same reason as apparatus claim 1 since the recited apparatus would perform the claimed method." A reading of Claims 1 and 15 clearly demonstrates that Claim 15 recites features that are not recited in Claim 1 and, thus recites a method that may not necessarily be performed by the apparatus of Claim 1. For example, Claim 1 recites an apparatus that receives a remotely originated request to disable the apparatus. However, Claim 15 recites causing a disable signal to be broadcast to a mobile device. In other words, while the method of Claim 15 may, in some embodiments, be used to generate and broadcast a request that may be received by the apparatus of Claim 1, it does not follow that the apparatus of Claim 1 would perform the method claimed in Claim 15. As such, Claim 15 recites features which have not been addressed in the rejection of Claim 1. Accordingly, the Office has failed to even allege with particularity that each feature recited in Claim 15 is taught or suggested by the cited references. It will thus be appreciated that the Office has failed to establish a *prima facie* case of anticipation or obviousness of Claim 15 and the rejection should be reversed on grounds of this clear error.

The Cited References Fail to Teach or Suggest Claims 15 and 28

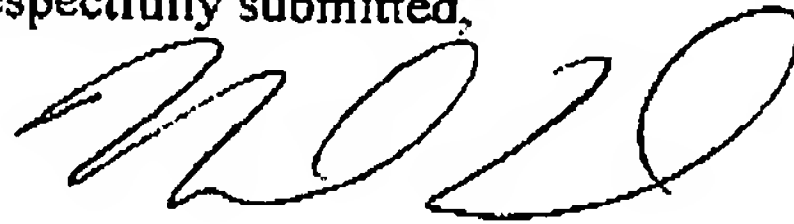
Moreover, the cited combination of Muthuswamy and Kagay fails to teach or suggest each feature recited in Claims 15 and 28. In this regard, the combination of Muthuswamy and Kagay fails at least to teach or suggest the features of determining a tracking function to activate on the mobile device, the tracking function being selected

based at least in part on one or more of a time that has passed since the mobile device was lost or stolen or a location in which the mobile device was lost or stolen, as recited in Claims 15 and 28 for at least those reasons discussed with respect to Claims 1 and 24. Applicants therefore respectfully submit that Claims 15 and 28 are patentably distinct from the cited references, taken alone or in combination, such that the rejection of Claims 15 and 28 should be reversed. Applicants additionally submit that Claims 15 and 28 are in condition for allowance.

The Rejection of the Dependent Claims Should Be Reversed

Because each of dependent claims includes each of the recitations of a respective independent base claim, Applicants further submit that the dependent claims are patentably distinguishable from the cited references, taken alone or in combination, for at least those reasons discussed above and thus the rejections of the dependent claims should be reversed.

Respectfully submitted,



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